Remarks

Entry of the amendment to Claim 1 after final is believed to be proper, since it simply moves the limitation of Claim 8, which has already been considered, into Claim 1. The amendment is made to sharpen focus on appeal.

(a) Claims 1, 2, 4, and 6 have been rejected under 35 U.S.C. §102 as being anticipated by Staron, USPN 5,805,230.

(b) Claims 3 and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Staron in view of Bednarek et al., USPN 6,009,116.

(c) Claims 7-12 have been rejected under 35 U.S.C. §103 as being unpatentable over Staron in view of Lawler, USPN 5,758,259.

(d) Claims 14, 15, and 18 have been rejected under 35 U.S.C. §103 as being unpatentable over Lemmons et al., USPN 6,266,814 in view of Legall et al., USPN 6,005,565.

(e) Claim 16 has been rejected under 35 U.S.C. §103 as being unpatentable over Lemmons et al. in view of Legall et al. and Bednarek et al.

(f) Claim 17 has been rejected under 35 U.S.C. §103 as being unpatentable over Lemmons et al. in view of Legall et al. and Allen et al., USPP 2003/0023742.

(a) The first rejection is the easiest to deal with. No matter how broadly it is attempted to read Claim 1, establishing a channel based on a zip code legitimately cannot be equated to establishing the channel based on a location ***within a building***. The language of Claim 1 is clear: the reference coordinate for establishing a channel is with respect to a building. Establishing a channel with respect to a zip code uses a different and

independent reference coordinate than claimed. A zip code not only contains space mostly made up of open areas, but it also says nothing about relative coordinate systems (i.e., with respect to buildings) that are inside the zip code.

More formally, the syllogism being employed in the rejection arrives at a false conclusion ("Staron teaches establishing a channel based on a location with respect to a dwelling") because it relies on a false premise. The false premise is this: because a TV must be in a dwelling located somewhere in Staron's zip code, then Staron "implicitly" teaches establishing a channel with respect to a location of a TV in a dwelling. However, since no dwelling, not even the Taj Mahal, spans multiple zip codes, Staron in fact does not establish anything with respect to a location inside a building, destroying the syllogism on which the rejection is predicated and failing to meet Claim 1.

Additionally, while limitations from the specification are not to be read into the claims, the claims must be interpreted in light of the specification, and the present specification clearly differentiates, for the skilled artisan reading it, geographic location from relative location inside a building. Indeed, Claim 1 as originally filed contained recitations of both different types of reference coordinates, further underscoring the fallacy in the syllogism being employed against Claim 1.

Faulty logic also underpins the rejection of dependent Claim 6. Contrary to the rejection, inputting a new zip code to alter channels is not the same thing as the explicitly recited manually input channels that are to alter heuristics. When the user in Staron moves channels up and down, the channel - but not the underlying heuristics as claimed - changes. Indeed, the rejection seems to recognize as much, acknowledging that a zip code change, not a channel change, is necessary to change heuristics.

(b) Dependent Claims 3 and 13 are patentable for the reasons above, and further because the claims would not result from the proposed combination of Staron with Bednarek et al. As readily admitted by the examiner, Staron says nothing about GPS, whereas in Bednarek et al. GPS appears to be used only for descrambling programming, not for indicating the location of a TV within a building. Bednarek et al. thus fails to suggest using GPS information in the way claimed.

(c) Combining Staron with Lawler would not arrive at Claims 7-12 for an important if somewhat subtle reason. Claim 7 requires that if a first input is sensed two or more times contemporaneously with a manually-input setting, the input is correlated to the setting, it being agreed by both Appellant and the examiner that Staron fails to teach this. However, neither does Lawler teach it. In Lawler, whatever the "input" being relied on, it is not a location or a time, in contrast to how "input" is defined in Claim 7. In fact, it appears in Lawler that Table 2 (used to automatically tune to a channel based on user preferences regardless of the current manually-input channel number) is constructed by automatically searching previously-watched programs for particular subject matter, maintaining a count for each subject, and then when the user turns the TV on, searching current programming for the subjects in Table 2 and then tuning to the channel that contains a subject with the highest count relative to other available programming subjects. In other words, there is no suggestion in Lawler to correlate anything with an input representing time or location, with any proposed modification of the references to reach Claim 7 thus plainly falling outside any fair prior art suggestion.

Appellant must comment on the rejections of Claims 8 and 9, because they make the point discussed above in relation to Claim 1. The examiner insists, without a shred of prior art evidence that the skilled

artisan would be so confused, on equating zip code with (1) location within a building (Claim 8) and also with (2) geographic location (Claim 9). "Geographic" location, as the name implies, refers to an earth-based reference coordinate, whereas "within a building" plainly is uncoupled from any particular geographic location.

(d) Lemmons et al. has been used as a teaching of inputting a location and/or time to establish an input, but admittedly fails to disclose highlighting anything on an EPG, with Legall et al. being resorted to for the shortfall. However, once again the references if combined as proposed would not reach the claim being rejected. Specifically, Claim 14 requires more than simply "highlighting" something. It requires using the input (of the location or time) to highlight some programs on an EPG and to lowlight and/or delete and/or skip other programs on the EPG, whereas in the relied-upon section of Legall et al. only channels meeting search filter criteria are highlighted and nothing is "lowlighted" or deleted or skipped. Thus, since the examiner freely admits that the primary reference teaches nothing about highlighting/lowlighting and since the secondary reference only highlights and then only based on criteria that are markedly different from what Claim 14 requires, combining the references as proposed would not arrive at Claim 14. In other words, there is no suggestion in either reference to highlight anything based on time or location, with any proposed modification of the references to reach Claim 14 thus plainly falling outside any fair prior art suggestion.

(e) For reasons advanced above in parts (b) and (d), Claim 16 is patentable.

(f) For reasons advanced above in part (d), Claim 17 is patentable.

The fact that Applicant has focussed its comments distinguishing the present claims from the applied references and countering certain rejections must not be construed as acquiescence in other portions of rejections not specifically addressed.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

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